

III. REMARKS

1. Claims 1, 3-5, 9, and 11-17 remain in the application.
2. Applicants respectfully submit that claims 1 and 5 are patentable over the combination of Crowley et al. (US 5,193,727, "Crowley"), Kurahashi et al. (US 2003/0222396, "Kurahashi") and Laussermair et al. (US 6,324,353, "Laussermair") under 35 USC 103(a).

The combination of Crowley, Kurahashi and Laussermair fails to disclose or suggest

wirelessly recording the post processing instructions on a transportable electronic information device located on a spool, while winding the printed media onto the spool, without marking any media with the post processing instructions;

transporting the electronic information device on the spool holding the printed media from an online printing/copying system where the printing operations occur to a separate offline post processing system where the post processing occurs; and

wirelessly playing back the post processing instructions from the information device on the spool at the offline post processing system for controlling offline post processing of the printed media while the media is unwound from the spool.

as recited by claim 1.

The Examiner properly points out that Crowley fails to disclose or suggest:

wirelessly recording the post processing instructions on a transportable electronic information device without marking any media with the post processing instructions;

transporting the electronic information device on a spool holding the printed media from an online printing/copying system where the printing operations occur to a separate offline post processing system where the post processing occurs; and

wirelessly playing back the post processing instructions from the information device at the offline post processing system for controlling offline post processing of the printed media while the media is unwound from the spool.

Applicant respectfully submits that Crowley also fails to disclose or suggest wirelessly recording the post processing instructions on a transportable electronic information device located on a spool, while winding the printed media onto the spool, without marking any media with the post processing instructions. Crowley has no disclosure related to an information device located on a spool, and no disclosure related to recording instructions onto the device while winding the printed media onto the spool.

Kurahashi also fails to disclose or suggest these features. Kurahashi discloses a storage device 1202 attached to a stacker tray 1207 that stores post processing information. However, the storage device is not located on a spool, and post processing instructions are not recorded while winding printed media onto the spool. Kurahashi only discloses using a stacker tray for holding and transporting media and the storage device is only found on the stacker tray. By comparing item 1207 as shown and described in Kurahashi with item 210 of the present application, it is clear that the stacker tray is not the equivalent of a spool.

In particular, the Examiner has cited container 400 "which is considered as the spool". However, container 400 comprises two sheet containing sections 400A and 400B. In turn, container 400 is part of containing device (stacker) 300. See paragraph [0373], emphasis added. It is respectfully submitted that the words "sheet" and "stacker" clearly indicate that container 400 holds stacked sheets, which is inconsistent with a spool being present. Also, the fact that the sheet goes around rollers is not the same as the presently claimed wound and unwound from the spool.

Furthermore, while Kurahashi discloses storing information in the device 1202 such as sheet size, job IDs, print numbers, the number of prints, the number of copies, etc., Kurahashi has no disclosure related to recording post processing instructions while winding the printed media onto the spool.

Kurahashi also fails to disclose or suggest wirelessly playing back the post processing instructions from the information device on the spool at the offline post processing system for controlling offline post processing of the printed media while the media is unwound from the spool. Because Kurahashi has no spool, Kurahashi cannot disclose or suggest wirelessly playing back the post processing instructions from the information device on the spool.

Applicant respectfully submits that Laussermair fails to disclose or suggest wirelessly playing back the post processing instructions from the information device on the spool at the offline post

processing system for controlling offline post processing of the printed media while the media is unwound from the spool. Applicant notes that Laussermair is presented in the present action to supply the feature of performing a post processing task while unwinding the media from the spool. However, the present claims recite "wirelessly playing back the post processing instructions from the information device on the spool at the offline post processing system for controlling offline post processing of the printed media while the media is unwound from the spool. None of the references cited above disclose or suggest playing back post processing instructions from an information device on a spool, and neither does Laussermair.

Because the combination of Crowley, Kurahashi and Laussermair fails to disclose all the features of claim 1, the cited combination fails to render independent claim 1 and dependent claim 5 unpatentable.

3. Applicants respectfully submit that claims 3 and 4 are patentable over the combination of Crowley, Kurahashi, Laussermair and Webster et al. (US 5,559,606, "Webster") under 35 USC 103(a).

Claims 3 and 4 depend from claim 1.

Webster fails to disclose or suggest the features of claim 1 missing from the combination of Crowley, Kurahashi, and Laussermair, that is,

wirelessly recording the post processing instructions on a transportable electronic information device located on a spool, while winding the printed media onto the spool, without marking any media with the post processing instructions;

transporting the electronic information device on the spool holding the printed media from an online printing/copying system where the printing operations occur to a separate offline post processing system where the post processing occurs; and

wirelessly playing back the post processing instructions from the information device on the spool at the offline post processing system for controlling offline post processing of the printed media while the media is unwound from the spool.

Therefore, the cited combination fails to render claims 3 and 4 unpatentable because the combination of Crowley, Laussermair, Kurahashi, and Webster fails to disclose or suggest all the features of claim 1.

4. Applicants respectfully submit that claims 9, 13, 14, 16 and 17 are patentable over the combination of Crowley, Kurahashi, Laussermair and Murata et al. (US 7,054,028, "Murata") under 35 USC 103(a).

The combination of Crowley, Kurahashi, Laussermair and Murata fails to disclose or suggest

an online printing/copying operation having a controller for determining post processing instructions for printed media and for wirelessly recording the post processing instructions on a transportable electronic information device positioned on a spool of the printed media, while winding the printed media onto the spool, without marking the post processing instructions on any media; and

an offline post processing operation operable to wirelessly play back the post processing instructions from the transportable electronic information device on the spool for controlling offline post processing of the printed media while the media is unwound from the spool,

as substantially recited by claims 9 and 14.

For all the reasons argued above, the combination of Crowley, Kurahashi, and Laussermair fails to disclose or suggest these features. Murata fails to disclose or suggest the features of Crowley, Laussermair, and Kurahashi missing from claims 9 and 14. Murata has no disclosure related to a transportable electronic information device positioned on a spool of printed media, and nothing related to wirelessly recording the post processing instructions on the transportable electronic information device, while winding the printed media onto the spool. Murata also fails to disclose or suggest playing back the post processing instructions from the transportable electronic information device on the spool.

At least for these reasons, the combination of Crowley, Kurahashi, Laussermair and Murata fails to render independent claims 9 and 14, and dependent claims 13, 16, and 17 unpatentable.

5. Applicants respectfully submit that claims 11, 12, and 15 are patentable over the combination of Murata, Crowley, Laussermair, Kurahashi, and Webster under 35 USC 103(a).

Claims 11 and 12 depend from claim 9 and claim 15 depends from claim 14.

Webster fails to provide the features of claims 9 and 14 missing from the combination of Murata, Crowley, Laussermair, and Kurahashi. Webster has no disclosure related to

an online printing/copying operation having a controller for determining post processing instructions for printed media and for wirelessly recording the post processing instructions on a transportable electronic information device positioned on a spool of the printed media, while winding the printed media onto the spool, without marking the post processing instructions on any media; and

an offline post processing operation operable to wirelessly play back the post processing instructions from the transportable electronic information device on the spool for controlling offline post processing of the printed media while the media is unwound from the spool,

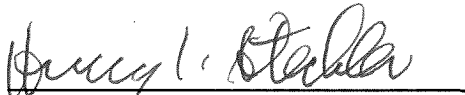
Therefore, the combination of Murata, Crowley, Laussermair, Kurahashi, and Webster fails to render claims 11, 12 and 15 unpatentable.

6. Further, throughout the Office Action the Examiner has stated "(same field of endeavor)". It is respectfully submitted that this is no longer the proper text for combining references. In particular, the Examiner must identify a "benefit or result" of the resulting combination, see *Ex parte Verify*, 93 USPQ 2d 1710, 1712. Since the Examiner has not done so, the claims are additionally patentable for this reason.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-0510.

Respectfully submitted,



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